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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

BP 3242

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on April 24, 2006

Signature

Typed or printed name Gary W. Hamilton

Application Number

10/821,575

Filed

April 9, 2004

First Named Inventor

Brian J. Campbell

Art Unit

2819

Examiner

Daniel D. Chang

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒

attorney or agent of record.

Registration number 31,834☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Signature

Gary W. Hamilton

Typed or printed name

(512) 338-9100

Telephone number

April 24, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐

*Total of _____ forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s):	Brian J. Campbell		
Assignee:	Broadcom Corporation		
Title:	High-Fanin Static Multiplexer		
Serial No.:	10/821,575	Filed:	April 9, 2004
Examiner:	Daniel D. Chang	Group Art Unit:	2819
Docket No.:	BP 3242	Customer No.:	34399

Austin, Texas
April 24, 2006

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PRE-APPEAL BRIEF STATEMENT OF REASONS

Sir:

Applicant requests review of the Final Rejection in the above-identified application. No amendments are being filed with the request. This request is being filed with a Notice of Appeal. The following sets forth a succinct, concise, and focused set of arguments for which the review is being requested.

CLAIM STATUS

Claims 1, 2, 5, 7, 8, 11, 13, 14, and 17 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,543,731 issued to Sigal (hereinafter "Sigal").

Claims 6, 12, and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sigal.

Claims 3, 4, 9, 10, 15, and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sigal in view of Horenstein's "Microelectronic Circuits & Devices," 1990 by Prentice-Hall, Inc. (hereinafter "Horenstein").

REMARKS

Claims 1-18 are pending in the application. Claims 1-18 are rejected.

Claim Rejections - 35 U.S.C. § 102

Claims 1, 2, 5, 7, 8, 11, 13, 14, and 17 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,543,731 issued to Sigal (hereinafter "Sigal"). Applicant traverses the rejection of the aforementioned claims under 35 U.S.C. §102(b). Specifically, Applicant respectfully submits that Sigal does not anticipate the combination of features recited in independent claims 1, 7 and 11. First, Applicant does not agree that the discussion in column 3, lines 33+ provides a basis for disclosure of the "second logic module" recited in independent claims 1, 7 and 11. Examiner states on page 2 of the January 23, 2006 Office Action that the second logic module is not shown, i.e., "Gate 2, not shown, but similar to Gate 1." Even if it could be assumed that Sigal provided the disclosure of a second logic module, it would necessarily be the same logic module as the Gate 1 in Figure 6 of Sigal. The logic module in Figure 6 does not comprise a first set of complementary select signals as recited in independent claims 1, 7 and 11. It is clear, therefore, that the alleged second logic module – which is not shown in Sigal – does not provide the set of complementary select signals recited in independent claims 1, 7 and 11. For this reason, at a minimum, the rejection of independent claims 1, 7 and 11 under 35 U.S.C. §102(b) should be removed and these claims should be passed to allowance.

Independent claims 1 and 7 recite that the capacitive loading of said first and second logic modules is isolated from said output line by the first and second gates, respectively. This feature is not shown in the Sigal reference. However, Examiner states that this feature is "inherent" in the NAND 1 shown in Sigal. Applicant respectfully submits that Examiner has failed to provide support for the assertion that this feature is inherent in the NAND 1 of Sigal. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be

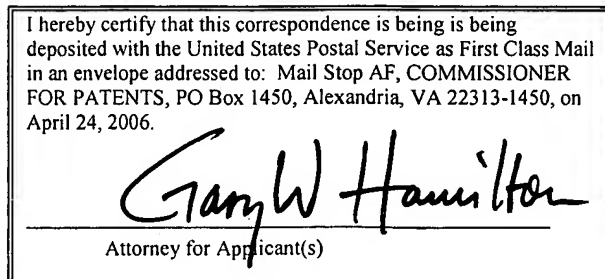
established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted) "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original) For this additional reason, the rejection of independent claims 1, 7 under 35 U.S.C. §102(b) should be removed and these claims should be passed to allowance.

Claim Rejections - 35 U.S.C. § 103

Claims 6, 12, and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sigal. Claims 3, 4, 9, 10, 15, and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sigal in view of Horenstein's "Microelectronic Circuits & Devices," 1990 by Prentice-Hall, Inc. (hereinafter "Horenstein"). The Horenstein reference provided by Examiner does not supply the teaching of a second logic module having a set of complementary select signals that is missing in the Sigal reference as discussed above. Applicant, therefore, submits that the rejection of claims 6, 12, and 18 under 35 U.S.C. §103(a) should be removed and these claims should be allowed for the reasons stated above.

CONCLUSION

In view of the amendments and remarks set forth herein, Applicant respectfully submits that all pending claims are in condition for allowance. Accordingly, Applicant requests that a Notice of Allowance be issued. Nonetheless, should any issues remain that might be subject to resolution through a telephone interview, the Examiner is requested to telephone the undersigned at 512-338-9100.



Respectfully submitted,


Gary W. Hamilton
Attorney for Applicant(s)
Reg. No. 31,834